

REMARKS

Claims 8-22 and 29-30 are rejected under 35 U.S.C. §112 as being indefinite. It is the position of the USPTO that the term "PowerTag identifier" renders each of these claims indefinite, that the Applicants fail to provide an explicit definition of the term in the specification, and that the term is not known in the art.

Applicants respectfully traverse this rejection in view of the file history of this application. This rejection is contradictory.

First, the original specification at page 7 line 8, to at least page 10 line 5, sets forth a thorough explanation of the power tag system and the power tag identifier

Second, the office actions mailed to the Applicants on March 25, 2005 and again on September 9, 2005, argue that the Danknick reference (U.S. 6,021,429) teaches a power tag identifier, which argument was opposed by the Applicants.

Now, however, the USPTO takes a new position with respect to the power tag identifier, as set forth above.

Applicants argue here that the power tag identifier is fully described and defined in the original specification and concur that the term is not known in the art.

Claims 1-30 are rejected under 35 U.S.C. §103 as being unpatentable over Guheen et al (US 6,957,186) "Guheen" and O'Connor et al (U.S. 5,745,568) "O'Connor".

This rejection is no longer applicable to the claims.

The power tag system assigns a unique power tag identifier linked to a configuration of systems and software reflecting a customer's changing installed solutions (spec. @ p.7 lines 8-16).

The independent claims include a solutions or PowerTag identifier being linked to a configuration of systems and software provided to be updated to reflect a customer's changing installed solution, whereby a customer may possess multiple such identifiers to reflect multiple installed solutions.

As the PTO recognizes in MPEP § 2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach the solutions or PowerTag identifier being linked to a configuration of systems and software provided to be updated to reflect a customer's changing installed solution, whereby a customer may possess multiple such identifiers to reflect multiple installed solutions.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPIP 2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches nor suggests providing the solutions or PowerTag identifier being linked to a configuration of systems and software provided to be updated to reflect a customer's changing installed solution, whereby a customer may possess multiple such identifiers to reflect multiple installed solutions.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

In view of all of the above, the allowance of claims 1-30 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application

Respectfully submitted,



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